

--Detailed description--

REMARKS

This application pertains to a novel pressure-sensitive adhesive composition having an outgassing level of not more than 50 µg/g, and to a process for producing it.

Claims 1-13 are pending.

Applicants note with appreciation that the Restriction Requirement has been withdrawn.

Two paragraphs of the specification are being amended herein. The paragraph from page 1 is being amended to correct the grammar, and the paragraph from page 4 is being amended to delete the reference to the claims. No new matter is added, and the scope of the disclosure is unaffected. The amendments are to the form of the paragraphs only.

Claims 1, 2 and 9-11 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harder et al (DE 19807752; corresponding to US 6,432,529). The Examiner views the '752 reference as teaching the same composition as now claimed, and as further teaching that it is low fogging. From this, the Examiner presumes that Harder's adhesive would inherently possess the claimed outgassing level.

There is, however, absolutely nothing in the '752 reference that would teach or suggest that an outgassing level as low as 50 µg/g is even possible, and certainly nothing that would teach or suggest any process by which such a low outgassing level may be achieved.

The adhesives disclosed by the '752 reference are said to have a residual solvent level of less than 1% by weight. This is far from 50 µg/g.

In addition, the Examiner will note that Applicants' achieve this low level of outgassing by concentrating the adhesive in an extruder using a distillation process in which entrainers are added. The '752 reference does not teach or suggest any corresponding method or, indeed, any method at all, by which Applicants' low level of outgassing can be reached. The teaching of the '752 reference could not therefore possibly lead those skilled in the art to Applicants' low outgassing level.

With respect to the Examiner's suggestion that Harder's adhesive would inherently possess the claimed outgassing level, it is respectfully pointed out that if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities,

and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference.

No person skilled in the art reading the Harder reference would have any idea that an outgassing level of 50 $\mu\text{g/g}$ was even a possibility. Applicants' outgassing level of 50 $\mu\text{g/g}$ is clearly not inherent in anything taught or suggested by Harder.

The rejection of claims 1, 2 and 9-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harder et al (DE 19807752, corresponding to US 6,432,529) should accordingly now be withdrawn.

Claims 1-13 stand rejected under 35 U.S.C. 103(a) as obvious over Harder DE 19807752 (=US 6,432,529) in view of Harder DE 4313008 (=US 6,613,870). The Examiner views Harder '008 as teaching a method by which the adhesives of Harder '529 could be treated, presumably to reach the low outgassing level claimed by Applicants.

Neither Harder reference teaches or suggests anything at all about outgassing levels of 50 $\mu\text{g/g}$. To the contrary, Harder '008 exemplifies his compositions as having proportions of volatile substances of 0.8% (i.e., 8000 $\mu\text{g/g}$), a far cry from Applicants' outgassing level of 50 $\mu\text{g/g}$.

Nothing to be found anywhere in either Harder reference would even remotely suggest the possibility of an outgassing level of 50 µg/g.

Accordingly, Applicants' claims cannot be seen as obvious over the Harder references, whether taken individually or in combination, and the rejection of claims 1-13 under 35 U.S.C. 103(a) as obvious over Harder DE 19807752 (=US 6,432,529) in view of Harder DE 4313008 (=US 6,613,870) should now be withdrawn.

Finally, Applicants gratefully acknowledge the initialed 1449 form attached to the Office Action of December 1, 2003. **A second Information Disclosure Statement** was filed on November 25, 2003, and most likely had not yet been matched with the PTO's file at the time the Examiner was acting on the instant Office Action. Applicants therefore respectfully call the Examiner's attention to the presence of such second IDS which, hopefully, has now found its way to her file.

In view of the present amendments and remarks it is believed that claims 1-13 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, applicant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

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By


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I hereby certify that this correspondence is being transmitted via facsimile no. 703-872-9306 to the United States Patent and Trademark Office, addressed to: Box Non-Fee Amendment, Hon. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 1, 2004.

By


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Date March 1, 2004